



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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In re

:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 CFR 10.7(c)  
:

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading her answers to questions 7, 8, 15 and 39 of the morning section and question 10 of the afternoon section of the Registration Examination held on April 17, 2002. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored

67. On August 12, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

### **OPINION**

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct

answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms “USPTO” or “Office” are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has not been awarded any additional points. No credit has been awarded for morning questions 7, 8, 15, or 39 nor for afternoon question 10. Petitioner's arguments for these questions are addressed individually below.

Morning question 7 reads as follows:

7. Evidence of unexpected results is relied upon to overcome a *prima facie* case of obviousness. Which of the following is incorrect?

- (A) The evidence must compare the claimed invention to the closest prior art.
- (B) The evidence must be commensurate in scope with the claims.
- (C) Data relied upon to show unexpected results need not cover the full range of the claims if one of ordinary skill in the art could ascertain a trend in the data that would allow that person to reasonably extend the probative value of the data to the full scope of the claims.
- (D) Unexpected results can be shown by factual evidence or, if no factual evidence is available to the applicant, by sound argument by the applicant's agent or attorney.
- (E) The evidence need not be in an affidavit or declaration under 37 CFR 1.132 if the evidence is presented in the specification of an application to which the applicant has attested.

7. The model answer: (D) is the most correct answer because mere attorney argument, unsupported by factual evidence, is insufficient to establish unexpected results. *See In re Geisler*, 116 F.3d 1465, 1470-71, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997). (A) is not the proper choice because such a comparison is required. *See In re Baxter Travenol Labs.*, 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991); *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984), and MPEP § 716.02(e). (B) is not the proper choice because evidence relied upon for overcoming a *prima facie* case of obviousness must be commensurate in scope with the claims. *See In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983); *In re Clemens*, 622 F.2d 1029, 1035, 206 USPQ 289, 296 (CCPA 1980), and MPEP § 716.03(a). (C) is not the proper choice because the unobviousness of a broader range recited in a claim can be proven by a narrower range of data provided that one of ordinary skill in the art could ascertain a trend in the data which would allow that person to reasonably extend the probative value of the data to the broader range. *See In re Kollman*, 595 F.2d 48, 56, 201 USPQ 193, 199 (CCPA 1979), and MPEP § 717.02(d). (E) is not the proper choice because the relied-upon evidence can be in the specification. *See In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

Petitioner argues that answer (E) is correct. Petitioner contends that she answered (E) because it is an incorrect answer, as this answer does not specify in which application the evidence must be presented. She argues that it merely states "in the specification of an application to which the applicant has attested." Petitioner asserts that the answer does not state that it is the present application or any other, therefore it is an incorrect answer and can be reasonably considered one of the best answers.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that answer (E) does not specify in which application the evidence must be presented, it is pointed out that this answer does state "in the specification of an application to which the applicant has attested." This means that the evidence is in the specification of the application in which the applicant is asserting unexpected results in order to overcome a *prima facie* case of obviousness, i.e., the instant application. See MPEP § 2144.08 (II. B. *Determining Whether Rebuttal Evidence Is Sufficient to Overcome the Prima Facie Case of Obviousness*). Accordingly, model answer (D) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 8 reads as follows:

8. On March 20, 2000, Patsy Practitioner filed a patent application on widget Y for the ABC Company based on a patent application filed in Germany for which benefit of priority was claimed. The sole inventor of widget Y is Clark. On September 13, 2000, Patsy received a first Office action on the merits rejecting all the claims of widget Y under 35 U.S.C. § 103(a) as being obvious over Jones in view of Smith. When reviewing the Jones reference, Patsy notices that the assignee is the ABC Company, that the Jones patent application was filed on April 3, 1999, and that the Jones patent was granted on January 24, 2000. Jones does not claim the same patentable invention as Clark's patent application on widget Y. Patsy wants to overcome the rejection without amending the claims. Which of the following replies independently of the other replies would not be in accordance with proper USPTO practice and procedures?

(A) A reply traversing the rejection by correctly arguing that Jones in view of Smith fails to teach widget Y as claimed, and specifically and correctly pointing out claimed elements that the combination lacks.

(B) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.131 that antedates the Jones reference.

(C) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.132 containing evidence of criticality or unexpected results.

(D) A reply traversing the rejection by stating that the invention of widget Y and the Jones patent were commonly owned by ABC Company at the time of the invention of widget Y, and therefore, Jones is disqualified as a reference via 35 U.S.C. § 103(c).

(E) A reply traversing the rejection by perfecting a claim of priority to Clark's German application, filed March 21, 1999, disclosing widget Y under 35 U.S.C. § 119(a)-(d).

8. The model answer: The correct answer is (D). The prior art exception in 35 U.S.C. § 103(c) only applies to references that are only prior art under 35 U.S.C. § 102(e), (f), or

(g). In this situation, the Jones patent qualifies as prior art under § 102(a) because it was issued prior to the filing of the Clark application. See MPEP § 706.02(l)(3). Answer (A) is a proper reply in that it addresses the examiner's rejection by specifically pointing out why the examiner failed to make a *prima facie* showing of obviousness. See 37 C.F.R. § 1.111. Answer (B) is a proper reply. See MPEP § 715. Answer (C) is a proper reply. See MPEP § 716. Answer (E) is a proper reply because perfecting a claim of priority to an earlier filed German application disqualifies the Jones reference as prior art.

Petitioner argues that answer (C) is correct. Petitioner contends that answer (C) is equally correct as Model Answer (D), because the question asks for a reply not in accordance with proper USPTO practice and procedures. Petitioner contends that under the facts presented by the question, answer (C) could potentially be an improper reply, as more facts are needed to ascertain the propriety of this reply.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the question asks for a reply not in accordance with proper USPTO practice and procedures, it should be noted that a reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.132 containing evidence of criticality or unexpected results may be used to overcome a *prima facie* case of obvious, if upon reconsideration of the entire record, such rebuttal evidence of nonobviousness is found to outweigh the evidence of obviousness. See MPEP § 716. Accordingly, model answer (D) is correct and petitioner's answer (C) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 15 reads as follows:

15. Able is a registered solo practitioner. Ben asks Able to prepare and prosecute an application for a utility patent. As part of the application, Able prepares a declaration and power of attorney, which Ben reviews and signs. Able files the application, the declaration, and power of attorney with the USPTO. Able quickly recognizes that help is necessary and contacts another registered practitioner, Chris, who often assists Able in such instances. Able, with Ben's consent, sends a proper associate power of attorney to the Office for Ben's application and directs that correspondence be sent to Chris. The examiner in the application takes up the application in the regular course of examination and sends out a rejection in an Office action. Chris sends a copy of the action to Ben to obtain Ben's comments on a proposed response. Unfortunately, after the first Office action, Able becomes terminally ill and dies. Ben does not know what to do, so Ben calls the examiner at the number on the Office action and explains that A died and Ben is worried how to proceed. Which of the following statement(s) is/are true?

(A) Chris should inform Ben that the Office will not correspond with both the registered representative and the applicant and therefore, Ben should not have any further contact with the Office and let Chris send in a proper response.

(B) Ben should send in a new power of attorney for anyone Ben intends to represent him before the Office.

(C) Ben should execute and sent to the USPTO a new power of attorney for any registered patent practitioner that Ben intends to have represent him before the Office.

(D) (B) and (C).

(E) None of the above.

15. The model answer: (C). MPEP § 406. Answer (C) is a true statement because the Ben may appoint a registered practitioner to represent him. Answer (A) is incorrect because the power of a principal attorney will be revoked or terminated by his or her death. Such a revocation or termination of the power of the principal attorney will also terminate the power of those appointed by the principal attorney. Therefore, Chris's associate power of attorney is revoked and Chris cannot continue representing Ben without a new power of attorney from Ben. Furthermore, the Office will send correspondence to both Chris and Ben in the event of notification of Able's death. (B) is not the best answer because it suggests Ben may appoint a non-practitioner to prosecute the application and because it does not require the power of attorney to be executed (*cf.* answer (C)). (D) is not the best answer because it includes (B). (E) is false because (C) is true.

Petitioner argues that answer (D) is correct. Petitioner contends that answer (D) includes answers (B) and (C), and that answer (B) is also a correct answer in that Ben should send in a new power of attorney for anyone Ben intends to represent him before the USPTO. The petitioner contends that the answer alludes to a "power of attorney" so she did not assume that the answer could include a non-practitioner. Petitioner also contends that she did not assume that Ben would send in any correspondence in a non-executed form. Petitioner asserts that many questions on the exam are correct without the inclusion of the terms "executed" preceding the submitted correspondence.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the answer alludes to a power of attorney, this assumption is inappropriate, as neither selection (B) nor the fact pattern specifically identifies whom Ben intends. Instead, selection (B) indicates that Ben may send in a power of attorney for anyone, as distinguished from selection (C) that indicates that Ben may send in a power of attorney for only a registered practitioner. Similarly, the assumption that the power of attorney would be executed is inappropriate as well. The directions for the examination state, "Do not assume any additional facts not presented in the questions." Petitioner's argument is based on additional facts not given in answer (B). Since "anyone" could include someone that is a non-registered practitioner, and is not limited to a registered practitioner, petitioner cannot make the assumption that Ben would appoint a registered practitioner. Ben may not appoint a non-practitioner, as suggested by selection (B). Accordingly, answer (B) is not the best answer because it suggests Ben may appoint a non-practitioner to prosecute the application and because it

does not require the power of attorney to be executed. Since (B) is not the most correct answer, therefore answer (D) is incorrect. Accordingly, model answer (C) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 39 reads as follows:

39. You are deciding whether to file continued prosecution applications (CPA) for prior applications before the earliest of payment of any issue fee on the prior application (and absent any petition under 37 CFR 1.313(c)), abandonment of the prior application, or termination of proceedings on the prior application. In which of the following circumstances is it proper to use the CPA procedure to file the application?

(A) To file a continuation-in-part application of a prior complete non-provisional utility application filed under 35 U.S.C. § 111(a). The non-provisional application has an actual filing date prior to November 29, 1999.

(B) To file a divisional application of a prior complete provisional application for a utility invention filed under 35 U.S.C. § 111(b). The provisional application has an actual filing date after June 8, 1995.

(C) To file a continuation utility application of a prior complete non-provisional utility application filed under 35 U.S.C. § 111(a). The non-provisional application has an actual filing date prior to May 29, 2000.

(D) To file a continuation utility application of a prior complete CPA utility application. The prior CPA application has an actual filing date of June 1, 2000, and is a continuation application of a prior complete utility application filed under 35 U.S.C. § 111(a) having an actual filing date of November 28, 1999.

(E) To file a divisional application of a prior complete non-provisional plant application filed under 35 U.S.C. § 111(a). The non-provisional application has an actual filing date after May 29, 2000.

39. The model answer: (C) is the most correct answer. Under 37 C.F.R. § 1.53(d), "(1) A continuation...application...of a prior non-provisional application may be filed as a continued prosecution application provided that: (i) The prior non-provisional application is either: a utility...application that was filed under 35 U.S.C. § 111(a) before May 29, 2000, and is complete as defined by § 1.51(b);...and (ii) The application under this paragraph is filed before the earliest of payment of: (A) Payment of the issue fee on the prior application, unless a petition under 37 C.F.R. § 1.313(c) is granted in the prior application; (B) Abandonment of the prior application; or (C) Termination of proceedings on the prior application." (A) is not the most correct answer. 37 C.F.R. § 1.53(d)(1) does



not authorize filing a continuation-in-part application as a CPA of a prior complete non-provisional utility application. (B) is not the most correct answer. 37 C.F.R. § 1.53(d)(1) does not authorize filing of a divisional application as a CPA of a prior complete provisional application. (D) is not the most correct answer. Pursuant to 37 C.F.R. § 1.53(d)(1)(i)(A), the prior application must be filed prior to May 29, 2000. Since the prior CPA was actually filed on June 1, 2000, a further CPA cannot be filed off that CPA. The filing date of the first application (November 28, 1999) is not relevant to 37 C.F.R. § 1.53(d)(1)(i)(A), and is only used for identification purposes in the first CPA. See, "Request for Continued Examination Practice and Changes to Provisional Application Practice; Final Rule," 65 F.R. 50092, 50093, right column, second paragraph (Aug. 16, 2000), 1238 O.G. 13 (Sept. 5, 2000). (E) is not the most correct answer. 37 C.F.R. § 1.53(d)(1)(i)(A) does not authorize the filing of a divisional or continuation application as a CPA of a prior complete non-provisional utility application filed on or after May 29, 2000.

Petitioner argues that answer (B) is correct. Petitioner contends that under 37 C.F.R. § 1.53(d), the answer described in answer (B) is not excluded, therefore (B) can reasonably be construed as a correct answer.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that (B) can reasonably be construed as a correct answer, (B) is excluded. Answer (B) states: "To file a divisional application of a prior complete provisional application for a utility invention filed under 35 U.S.C. § 111(b). The provisional application has an actual filing date after June 8, 1995." However, 37 C.F.R. § 1.53(d)(1) applies to non-provisional applications filed under 35 U.S.C. § 111(a), and does not authorize filing of a divisional application as a CPA of a prior complete provisional application filed under 35 U.S.C. § 111(b). Accordingly, model answer (C) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 10 reads as follows:

10. A maintenance fee in the correct amount is received by the USPTO on February 8, 2001, prior to the due date. The maintenance fee payment includes identification of a U.S. patent number. In accordance with proper USPTO rules and procedure, in which of the following situations may the USPTO return the maintenance fee payment?

(A) The maintenance fee payment is submitted by the patentee's grandmother, without authorization by the patentee, and includes identification of the U.S. application number for patent.

(B) The maintenance fee payment is submitted by the attorney of record in the application, without authorization by the patentee, and includes identification of the U.S. application number for the patent.

(C) The maintenance fee payment is submitted by the attorney of record in the application, with authorization by the patentee, and does not include identification of the U.S. application number for the patent.

(D) (A) and (B).

(E) None of the above.

10. The model answer: (C) is the most correct answer. 37 C.F.R. § 1.366(c) (effective September 8, 2000), “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54649 (Sept. 8, 2000). Under 37 C.F.R. § 1.366(a), any person or organization may pay maintenance fees and any necessary surcharges on behalf of a patentee. Authorization by the patentee is not required. 37 C.F.R. § 1.366(c) states, “If the payment includes identification of only the patent number (i.e., does not identify the application number of the United States application for the patent on which the maintenance fee is being paid), the Office may apply the payment to the patent identified by patent number in the payment or may return the payment.” Only in (C) does the USPTO have the option of returning the maintenance fee. (A) and (B) are each incorrect.

(D) is incorrect because (A) and (B) are incorrect. (E) is incorrect because (C) is correct.

Petitioner argues that answer (E) is correct. Petitioner contends that this question is flawed because the rule does not provide for a maintenance fee submitted where there is no identification of the patent or application.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that this question is flawed because the rule does not provide for a maintenance fee submitted where there is no identification of the patent or application, it should be noted that the question is not flawed, as it does include the fact that “The maintenance fee payment includes identification of a U.S. patent number” (see afternoon question 10). Since the maintenance fee payment includes identification of a U.S. patent number, but answer (C) does not include identification of the U.S. application number for the patent, then only in (C) does the USPTO have the option of returning the maintenance fee. Accordingly, model answer (C) is correct and petitioner’s answer (E) is incorrect.

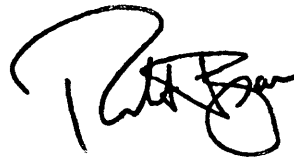
No error in grading has been shown. Petitioner’s request for credit on this question is denied.

**ORDER**

For the reasons given above, no points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 67. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read "Robert J. Spar", is positioned above a horizontal line.

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Robert J. Spar  
Director, Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy